

REMARKS/ARGUMENT

Status Of The Claims

In this amendment, Claims 1, 8, 43, and 44 have been amended to clarify the reserve alkalinity limit in the presence of an acidic soil. The changes presented herewith, taken with the following remarks, are believed sufficient to place Claims 1-10, 12-35, and 41-44 in condition for allowance.

Formal Matters

Applicant's election with traverse of Group I, Claims 1-35 and 41-44, was acknowledged and the restriction requirement was made final. The objections/rejections set forth in Paper #5 have been withdrawn.

103(a) Rejections

It is basic patent law that the rejections of claims under 35 U.S.C. §103 must comport with the classic standard set forth in *Graham v. John Deere Company* 383 US 1, 148 USPQ 459 (1966); see also MPEP Section 706. The Supreme Court's guidance in that landmark case, requires that, to establish a *prima facie* case of obviousness, the USPTO must:

- (1) Set forth the differences in the claims over the applied references;
- (2) Set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and
- (3) Explain why the proposed modification would have been obvious.

To satisfy Step (3), the Patent Office must identify where the prior art provides a motivating suggestion to make the modification proposed in Step (2). See *In re Jones*, 958 F2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992). The mere fact that the prior art may be modified as suggested by the Patent Office does not make the modification obvious unless the prior art suggests the desirability of the modification. See *In re Fritch* 922 F2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992).

1. **Claims 1-8, 10-29, 33-35, 41, and 42 are rejected by the Examiner under 35 U.S.C. 103(a) as allegedly defining obvious subject matter over Feng (US 5,929,007) (hereinafter "Feng") in view of Trinh et al. (U.S. Patent No. 6,194,362) (hereinafter "Trinh (1)").**

As described on pages 4-7 of the Office Action, the Examiner asserts that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a cleaning composition containing a solvent, an odor masking perfume, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success due to the broad teachings of Feng in combination with the cleaning

composition of Trinh (1). The Examiner asserts that the broad teachings of this combination would encompass compositions having the same physical parameters as recited by the instant claims. The Applicants respectfully disagree.

Claims 1 and 8, as amended, are commonly directed to hard surface cleaning compositions for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5 in the presence of an acidic food soil. Claims 2-7, 10-29, 33-35, and 41-42 directly or ultimately depend upon Claim 1, as amended.

It is improper to assume that the Feng reference encompasses the same limit on reserve alkalinity, as claimed by the Applicants, under a theory of inherency. “In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art” (emphasis added) *See, e.g., In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

In setting a limit to less than about 5 on the reserve alkalinity in the presence of an acidic food soil, the Applicants have found it desirable for consumers since it decreases the risk for skin damage during use (see specification, page 4, lines 4-13). The Feng reference is silent on both the concept of reserve alkalinity, and the need or desirability for setting a limit (i.e. to decrease risk of damaging skin). By asserting, under the theory of inherency, that the Feng disclosure encompasses the setting of a limit on reserve alkalinity in the presence of an acidic food soil, the Examiner is exercising nothing more than hindsight reconstruction.

Although Feng teaches a composition comprising a pH of at least 12.5 (see Feng, col. 6, lines 54-59) for use on greasy soil deposits (Feng, col. 7, lines 44-45), and discloses low dermal irritation with use (see Feng, col. 7, lines 45-46), Feng is silent as to the need for controlling the alkalinity in the presence of acidic food soil. More importantly, Feng discloses that at a pH of “13 or higher” its composition should be a skin irritant (see Feng, col. 7, lines 57-64), yet it “surprisingly” finds that their composition is not irritating to skin at these higher pH levels. This is a teaching away from the need to control reserve alkalinity in order to protect skin from damage due to high alkalinity. Thus, there can be found no motivation in Feng to limit reserve alkalinity to less than about 5 in the presence of acidic food soil, as is claimed by the Applicants.

Without such motivation, the concept of setting a limit on reserve alkalinity in the presence of acidic food soil does not flow from, and definitely does not “necessarily” flow from, the teachings of Feng according to *In re Robinson* (*supra*, page 9). Therefore, the Applicants submit that the setting of a limit on reserve alkalinity to less than about 5 in the presence of acidic soil, as provided

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in the instant claims, would not be an inherent characteristic of the Feng composition, as asserted by the Examiner.

With regard to the Examiner's request for the Applicants to present data showing unexpected results, the Applicants submit that data need not be presented to obviate this rejection. As already discussed above, simply because Feng teaches that its compositions are highly alkaline does not imply a desirability, nor provide a motivation, for one skilled in the art to set a limit on reserve alkalinity in the presence of an acidic food soil, as claimed by the Applicants. Since the Feng reference actually teaches away from the setting of a reserve alkalinity limit due to the fact that they surprisingly found no skin irritation with compositions having a pH of 13 and higher, the concept of limiting the reserve alkalinity in their compositions to reduce the risk of skin damage in the presence of acidic food soil would be unnecessary. Without motivation, there is no support for an obviousness rejection under § 103. Thus, the need for the presentation of data showing surprising results would be unnecessary.

Trinh (1) fails to solve the deficiencies of Feng. It is interesting to point out that while the Trinh (1) reference is directed to glass cleaning compositions, it is not directed to hard surface cleaners useful in removing cooked-, baked- or burnt-on "acidic" food soils. As a result, like Feng, Trinh (1) is also silent as to the problem of the removal of cooked-on or baked-on acidic soils. Furthermore, it also cannot be properly construed that setting such a limit to about 5 on reserve alkalinity in the presence of an acidic food soil "*necessarily*" flows from the silence in Trinh (1), as required by *In re Robertson* (*supra*, page 9). In addition, since neither Feng nor Trinh (1) provide a motivation for setting such a limit, as presently claimed, in accordance with *In re Fritch* (*supra*, page 8), the Feng reference in combination with the Trinh (1), fails to render Claims 1-8, 10-29, 33-35, 41, and 42, as amended, obvious under §103. Reconsideration and withdrawal of the rejection is requested.

2. **Claim 30 is rejected by the Examiner under 35 U.S.C. 103(a) as allegedly defining obvious subject matter over Feng in view of Trinh (1) as applied to Claims 1-8, 10-29, 33-35, 41, and 42 above, and further in view of Ofosu-Asante et al. (U.S. Pat. No. 5,739,092) (hereinafter "Ofosu-Asante").**

The Examiner asserts that the broad teachings of this combination would encompass compositions having the same physical parameters as recited by the instant claim. The Applicants respectfully disagree.

Claim 30 is directed to a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5 in

the presence of an acidic food soil, and a salt having a divalent cation. Claim 30 is dependent upon Claim 1, as amended. As described above, both Feng and Trinh (1) are silent as to the problem of the removal of cooked-on or backed-on acidic soils and the desirability to set a limit on the reserve alkalinity to reduce the risk of skin damage during use.

Ofosu-Asante fails to solve the deficiencies of both Feng and Trinh (1). The Ofosu-Asante reference is directed to a liquid or gel dishwashing detergent said to have good grease removal benefits. However, there is no teaching or suggestion in Ofosu-Asante that its detergent composition is used for removing cooked-, baked- or burnt-on acidic soils. Like Feng and Trinh (1), Ofosu-Asante is also silent on the need for a reserve alkalinity in the presence of an acidic food soil or the desirability to set a limit on such a reserve alkalinity, if any (i.e. to reduce the risk of skin damage during use). Furthermore, like Feng, Ofosu-Asante teaches away from the concept or need of setting a limit on reserve alkalinity, since it discloses that its compositions “manifest mildness to the skin” (see Ofosu-Asante, col. 6, lines 43-46). Thus, like, Feng, there is simply no motivation in Ofosu-Asante to control reserve alkalinity.

Since the Ofosu-Asante reference does not teach or suggest a reserve alkalinity nor the need for setting a limit on reserve alkalinity in the presence of an acidic food soil, it cannot be properly construed that setting such a limit to about 5 on reserve alkalinity in the presence of an acidic food soil “necessarily” flows from the silence in Ofosu-Asante, as required by *In re Robertson* (*supra*, page 9). In addition, since neither Feng, Trinh (1) nor Ofosu-Asante provide a motivation for setting such a limit, as presently claimed, in accordance with *In re Fritch* (*supra*, page 8), the Feng reference in combination with Trinh (1) and/or Ofosu-Asante, fails to render Claim 30 obvious under §103. Reconsideration and withdrawal of the rejection is requested.

3. Claims 31 and 32 are rejected by the Examiner under 35 U.S.C. 103(a) as allegedly defining obvious subject matter over Feng in view of Trinh (1) as applied to Claims 1-8, 10-29, 33-35, 41, and 42 above, and further in view of JP 8151597 (hereinafter “JP ‘597”).

The Examiner asserts that the broad teachings of this combination would encompass compositions having the same physical parameters as recited by the instant claims. The Applicants respectfully disagree.

Claims 31 and 32 are directed to a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5 in the presence of an acidic food soil, and directly or ultimately depend upon Claim 1, as amended. Claim 31 additionally comprises a thickening system comprising synthetic smectite type clay thickening agent having an average platelet size of less than about 100 nm. According to Claim

32, the thickening system comprises a mixture of a synthetic smectite type clay-thickening agent having an average platelet size of less than about 100 nm and a natural gum.

As stated above, both Feng and Trinh (1) are silent as to the problem of the removal of cooked-on or baked-on acidic soils. As stated before, neither reference teaches or suggests the need to maintain a reserve alkalinity in the presence of an acidic food soil nor sets a limit on the reserve alkalinity to reduce the risk of skin damage during use.

JP '597 fails to solve the deficiencies of both Feng and Trinh (1). The JP '597 reference is directed to a liquid detergent composition comprising a clay mineral having specific properties. There is no teaching or suggestion in JP '597 that the detergent composition described therein is useful for removing cooked-, baked- or burnt-on acidic soils. Like Feng and Trinh (1), JP '597 is also silent on the need for a reserve alkalinity in the presence of an acidic food soil. In addition, the JP '597 reference does not teach or suggest a need to set a limit on such a reserve alkalinity to decrease the risk for skin damage.

Since the JP '597 reference does not teach or suggest the need to set a limit on its reserve alkalinity in the presence of an acidic food soil, it cannot be properly construed that setting such a limit to about 5 on reserve alkalinity in the presence of an acidic food soil "*necessarily*" flows from the silence in JP '597, as required by *In re Robertson* (*supra*, page 9). In addition, since neither Feng, Trinh (1) nor JP '597 provide a motivation for setting such a limit, as presently claimed, in accordance with *In re Fritch* (*supra*, page 8), the Feng reference in combination with the Trinh (1) or JP '597, fails to render Claims 31 and 32 obvious under §103. Reconsideration and withdrawal of the rejection is requested.

4. Claims 1-8, 10-29, 33-35, 41-44 are rejected by the Examiner under 35 U.S.C. 103(a) as allegedly defining obvious subject matter over Trinh (1).

The Examiner asserts that the broad teachings of this combination would encompass compositions having the same physical parameters as recited by the instant claims. The Applicants respectfully disagree.

Claims 1, 8, 43 and 44 are either commonly directed to or refer to a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5 in the presence of an acidic food soil. Claims 2-7, 10-29, 33-35, and 41-42 ultimately depend upon Claim 1, as amended.

For the reasons stated above, it cannot be properly construed that setting such a limit to about 5 on reserve alkalinity in the presence of an acidic food soil "*necessarily*" flows from the silence in Trinh (1), as required by *In re Robertson* (*supra*, page 9). In addition, since Trinh (1) does not teach, suggest, nor provide a motivation for setting such a limit, as presently claimed, in accordance with *In*

re Fritch (supra, page 8), Trinh (1) fails to render Claims 1-8, 10-29, 33-35, and 41-44 obvious under §103. Reconsideration and withdrawal of the rejection is requested.

5. Claim 9 is rejected by the Examiner under 35 U.S.C. 103(a) as allegedly defining obvious subject matter over Trinh (1) or Trinh (1) as applied to the rejected claims above, and further in view of Trinh et al. (U.S. Pat. No. 6,001,789) (hereinafter “Trinh (2)”).

The Examiner asserts that the broad teachings of this combination would encompass compositions having the same physical parameters as recited by the instant claims. The Applicants respectfully disagree.

Claim 9 is directed to a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5 in the presence of an acidic food soil, and a cyclodextrin malodor-control agent.

Trinh (2) fails to solve the deficiencies of Trinh (1). Like Trinh (1), Trinh (2) is also silent on the need for a reserve alkalinity in the presence of an acidic food soil. Furthermore, the Trinh (2) reference does not teach or suggest a need to set a limit on such a reserve alkalinity to reduce the risk of skin damage. Since neither the Trinh (1) nor the Trinh (2) reference teach or suggest the need for a reserve alkalinity in the presence of an acidic food soil, it cannot be properly construed that setting such a limit to about 5 on reserve alkalinity in the presence of an acidic food soil “necessarily” flows from the silence in Trinh (1) and/or Trinh (2), as required by *In re Robertson (supra, page 9)*. In addition, since neither Trinh (1) nor Trinh (2) provide a motivation for setting such a limit, as presently claimed, in accordance with *In re Fritch (supra, page 8)*, the Trinh (1) reference alone, or in combination with Trinh (2), fails to render Claim 9 obvious under §103. Reconsideration and withdrawal of the rejection is requested.

Double Patenting Rejection

Claims 1-35 and 41-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over Claim 37-42 of 09/909403 and Claims 87-91 of 09/909288. Applicants submit that Claims 1, 8, 43, and 44, as amended, obviate this double patenting rejection as neither application requires a hard surface cleaning composition for removing cooked-, baked- or burnt-on acidic soils wherein the composition comprises a reserve alkalinity of less than about 5 in the presence of an acidic food soil. Reconsideration and withdrawal of the rejection is requested.

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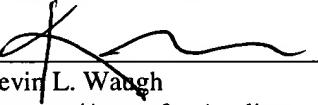
CONCLUSION

It is believed that the above represents a complete response to the rejections under 35 U.S.C. § 103(a), and places the pending claims in better condition for consideration under appeal. Reconsideration and an early allowance are requested.

Respectfully submitted,

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